

**Amendments to the Drawings**

The attached sheets of drawings include changes to  
Fig. 4. This sheet replaces the original sheet containing  
Fig. 4. In Figure 4, previously omitted element 5 has been  
added.

Attachment: Replacement Sheet

Annotated Sheet Showing Changes

## **REMARKS/ARGUMENT**

### **I. Status of the Claims**

Claims 1-27 are pending.

Claims 1-27 are rejected.

### **II. Foreign Priority**

Applicants enclose a certified copy of Japanese Application JP2002-26311, priority not claimed. Applicants further enclose a certified copy of JP2003-084232, priority claimed with translation to satisfy the requirements under 35 U.S.C. 119(b).

### **III. Drawings**

Applicant enclose an amended copy of FIG. 4 that addresses the feature of the resin as embodied in claims 4, 11, 13, 20, 22 and 26. The amendment of the drawing is supported by the specification as originally filed and contains no new matter. Entry of the amended FIG. 4 is respectfully requested.

### **IV. Information Disclosure Statement**

The Applicants acknowledge that the references listed in the specification must be submitted in an IDS for consideration.

**V. Rejections Under 35 U.S.C. § 102**

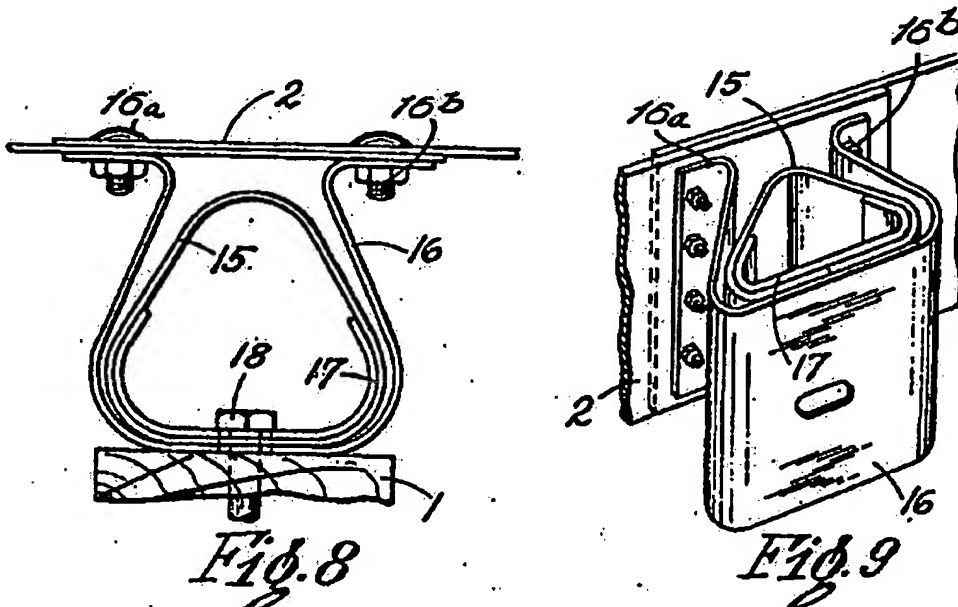
Claims 1-3, 5-10, 12, 14-19, 21, 23-25 and 27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Berk (US 2,047,992) herein after the "Berk '992 patent." The Applicants amends independent claims 1, 17 and 24 to more particularly point out what the applicants consider to be their invention of a shock-absorbing guardrail that does not produce any elastic restoring force after collision.

The Applicants amend independent claims 1, 17 and 24 to point out elements of the invention that are not taught by the Berk '992 patent that teaches solely the use of elastic restoring force elements (springs). The Berk '992 patent teaches the following about figures 8 and 9 on page 1, column 2 lines 15 to 55:

*Figures 8 and 9 illustrate a modified form of post spring connection including **a tubular spring 15, and a curved spring member 16 secured at its midportion to the posts 1,** surrounding the tubular spring 15 and spaced therefrom, and normally supporting the rail 2 out of contact with the tubular spring. The ends of the spring 16 are secured to the rail 2 as at 16a and 16b. **A supplemental spring 17 may be positioned within the spring 15, if desired. The springs 15, 16 and 17 are secured to the post by means of bolt 18.***

*When light loads are applied to the rail at an angle either between the posts or at one of the posts, the rail supporting springs and the end tensioning springs cooperate to resist and absorb such loads. When the loads are in excess of the load resisting ability of the rail supporting springs, the rail moves laterally and contacts with the tubular springs. Thereupon, the tubular springs as well as all the springs cooperate to resist and absorb such heavy*

loads applied longitudinally as well as transversely of the rail. For example in the post spring construction illustrated in Figures 5, 6, and 7 the slot 6 permits the rail to move longitudinally to a limited extent under light loads applied to the rail. When under excessive loads the rail tends to move beyond said limited extent, the spacer blocks 7 engage the vertical side of the slots 6, and there-upon the tubular springs 3 also resist further longitudinal movement of the rail. Similarly, light loads applied transversely of the rail move the rail toward the posts. This movement is resisted by the springs 4 until the rail contacts with springs 3 when that spring also resists further movement of the rail. In the modified post spring construction illustrated in Figures 8 and 9 when light loads are applied longitudinally as well as laterally of the rail the rail supporting springs 16 permit the rail to move longitudinally as well as laterally to a limited extent and such light loads are resisted and absorbed by the springs 16 and the end springs 13. When loads are applied to the rail which are greater than the load resisting ability of the springs 16 these springs yield and the rail comes into contact with the tubular springs 15. The tubular springs 15 resist and absorb the heavy loads. In this way the end and rail supporting springs cooperate to resist and absorb the light loads while all the springs cooperate to resist and absorb heavy loads. (Emphasis added)



The highlighted portions presented above of the Berk '992 patent teaches that the elements contained in figures 7-9 are meant to resist force and not absorb force by crushing as required by the Applicants' claims. The springs (elastic force) of FIG. 8 and FIG. 9 would not motivate one skilled in the art to produce a structure having solely a dampening force as specifically claimed by the Applicants without the use of improper hindsight reasoning. The Applicants' specification clearly teaches, and the claims particularly point out that the mid-filler section deforms irreversibly upon impact to reduce harm to the vehicle and occupants of the vehicle that impact the Applicants' claimed invention and that the Applicants' claimed invention does not produce any elastic restoring force after collision. Patent law is clear that it is the overall teaching of the prior art and not random elements. The Berk '992 patent now clearly teaches away from the Applicants claimed invention.

Claims 1-3, 5-10, 12, 14-19, 21, 23-25 and 27 as amended are not taught by the Berk '992 patent.  
Reconsideration and removal of the anticipation rejection

of claims 1-3, 5-10, 12, 14-19, 21, 23-25 and 27 is respectfully requested.

**VI. Rejections Under 35 U.S.C. § 103(a)**

Claims 4, 11, 13, 20, 22 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Berk (US 2,047,992) herein after the "Berk '992 patent." The Berk '992 patent does not teach each and every element of amended independent claims 1, 17 and 24 as discussed above. Claims 4, 11, 13, 20, 22 and 26 depend from amended independent claims 1, 17 and 24, which are allowable over the Berk '992 patent. The examiner again fails to even provide a prima facie case of obviousness as required for the rejection of claims 4, 11, 13, 20, 22 and 26.

Furthermore, the examiner is requested to replace his obviousness rejection of claims 4, 11, 13, 20, 22 and 26 based upon personal knowledge with either a declaration attesting to the facts or a citation of the art that contains the teaching required to produce the applicants claimed invention. The obviousness rejection is improperly based upon a combination of the examiner's personal knowledge with the Berk '992 that teaches away from shock absorbing resin by requiring a spring to prevent permanent deformation.

A prior art reference must be considered for all it teaches and discloses including disclosure that teaches away from the invention. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 U.S.P.Q. 657 (Fed. Cir. 1985), cert. Denied, 475 U.S. 1017 (1986). To do otherwise would allow references to be considered piece meal, and an applicant's disclosure to be considered as a blue print, the ``essence of hindsight''. *In Re Dembiczak*, 175 F.3d at 999 (internal citation omitted). The examiner fails to even provide a reference that would teach the Applicants' invention involving the use of a shock absorbing resin as required by patent law. Here the examiner improperly uses the Applicants' specification and claims as a template to use the shock absorbing resin using a reference that specifically teaches away from the use of permanent deformation elements. Reconsideration and removal of the obviousness rejection of claims 4, 11, 13, 20, 22 and 26 is respectfully requested.

#### **VII. Amendment of Claims**

The amendment of claims 1, 17 and 24 does not add new matter. The language added to the claims furthermore does not require a further search because it just clarifies an element already present and should be entered to allow the application to advance to issuance.



**VIII. Conclusion**

Based on the foregoing, it is respectfully requested that all rejections be withdrawn and the application be passed to issue.

Respectfully submitted,

Lorusso & Loud

Jeffrey D. Washville

Dated: 19 JUL 05

Reg. No. 46,366

15 Rye Street, Suite 312  
Pease International Tradeport  
Portsmouth, NH 03801  
Tel.: (603) 427-0070  
FAX: (603) 427-5530

ENC: JP2002-262311  
JP2003-084232  
English Translation JP2003-084232  
Amended Figure  
Replacement Figure

**Certificate Under 37 C.F.R. §1.8**

The undersigned hereby certifies that this paper along with any paper or document referred to therein as being attached or enclosed, is being mailed with proper postage or faxed to (603) 872-9306 and directed to the Commissioner for Patents, Mail Stop AF Amendment, P.O. Box 1450, Alexandria, VA 22313-1450- This 19<sup>th</sup> day of JULY 2005.

Jeffrey D. Washville





Appl. No. 10/690,187  
Response of Jul. 19, 2005  
Reply to Office Action of Apr. 19, 2005  
Annotated Sheet Showing Changes

Fig.4

